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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,808	08/24/2000	Roland Fischer	F-6485	9821

7590  
Jordan & Hamburg  
122 East 42nd Street  
New York, NY 10168

11/06/2002

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/06/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/509,808

Applicant(s)

FISCHER ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8-19-02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) 31-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**RESPONSE TO REQUEST FOR RECONSIDERATION**

1. Applicant's election with traverse of Group I (claims 24-31) in Paper No. 8 is acknowledged.

The traversal is on the ground(s) that there is a single technical relationship among the claimed inventions, giving unity of invention between Groups I, II and III. This is not found persuasive because applicants fail to point out what the single general inventive concept is of the inventions. Applicant states that each of the claims include the technical feature providing geometrically defined near surfaces areas having altered properties, i.e., that of solidified wood melts free from pyrolytic degradation products. Not only does JP 09155814 meet this claim limitation, but XP 002096973 also meets this limitation.

To reiterate the lack of unity, 37 C.F.R. 1.475 provides that there exists unity of invention only when there is a special technical feature. "Special technical feature" is defined by 37 C.F.R. as those technical features which define a contribution over the prior art. Since Applicants' special technical feature is solidified wood melt free from pyrolytic degradation, JP 09155814 and XP 002096973 discloses solidified wood melt with no regard or mention of pyrolytic degradation; consequently, the special technical feature of the instant invention does not define a contribution over the prior art. As a result, lack of unity of invention exists.

Furthermore, a search for a substrate would not be the same search as a method of manufacturing a substrate. 37 CFR 1.499, however, provides that an examiner may require an

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election if lack of unity of invention is found to exist. As indicated above, lack of unity of invention does exist; consequently, the requirement is still deemed proper and is therefore made **FINAL**.

2. Claims 32-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant timely traversed the election requirement in Paper No. 8. A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections – 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 24-31 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claims 24-31, "characterized" is a relative term and therefore indefinite.

b. In claim 26, "visually different" is indefinite. It is unclear what the near surfaces areas are visually different from.

c. In claim 27, "higher hardness and abrasion resistance" are indefinite. It is unclear how high the hardness and abrasion resistance are because they are not compared to anything. The hardness and abrasion resistance lack a requisite degree.

***Claim Rejections – 35 USC § 103(a)***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 24-26, 28-31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Razi et al. (U.S. 5,417,904).

7. Razi discloses a wood component in which the wood is in a molten condition (column 1, lines 59-65). Applicant claims 'cell walls melted in one or several cutting directions.' This is directed to a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Razi discloses the molten wood can be altered (column 2, lines 4-14) where the melt is formed of at least on thermoplastic particles (column 1, lines 59-62). Razi is silent as to the wood melts being free from pyrolytic degradation as per instant claim 24. Since no such degradation is disclosed as being present, the limitation of claim 24 is met. Razi does not disclose the wood melted areas being

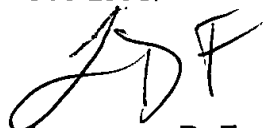
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visually different from non-melted wood and their optical properties. It would have been obvious to one of ordinary skill in the art that the wood melted areas would have different properties from the non-melted wood because when a substance goes through a phase change from solid to a liquid, the substance and its property experience a change.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

